

## **PRELIMINARY REMARKS**

This is a continuation application of Serial No. 09/818,362, and Applicant's preliminary remarks are directed in part to the prosecution of certain claims carried over from that application. In the parent application, the examiner rejected certain claims as being either anticipated in view of U.S. Patent No. 6,097,991 to Hamel (claims 5-7), or that such claims were obvious over Hamel in view of Hohner, U.S. Patent No. 5,437,044 (claims 10-13). Applicant has carefully reviewed the arguments presented in the prior prosecution and respectfully requests consideration of the previously rejected claims as well as the newly added claim in view of the remarks presented below.

### **Anticipation Under 35 U.S.C. §102**

The Federal Circuit has stated on multiple occasions that in order to reject a claim under Section 102, there must be identity of invention. *See Akzo N.V. v. US. Intern. Trade Comm'n*, 1 U.S.P.Q. 2d 1241, 1245 (Fed. Cir. 1986) ("Under 35 U.S.C. § 102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art"), cert. denied, 482 U.S. 909 (1987). Moreover, an anticipatory reference must be enabling and teach all aspects of the claimed invention. *Scripps Clinic & Research v. Genetech Inc.*, 18 U.S.P.Q. 2d 1001, 1010 (Fed. Cir. 1991) ("Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference . . . there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention."). The initial burden is on the Patent Office to show that identity of invention

exists. *In re Warner*, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967), cert. denied, 389 U.S. 1057 (1968).

### **Claims 15 - 17**

Claim 15 (previously Claim 5 of the parent application) was rejected as being anticipated by Hamel. Hamel discloses an automatic identification of features associated with an audio system based on the selection of an associated bezel. [Abstract]. "It is desirable to have an audio system which allows for various models with the same hardware, while allowing for different software base features to be changed for a given model of audio system based upon the corresponding model of bezel selected." [Col. 1, ll. 49 - 53]. Tabs on the bezel are recognized by receptors on the audio device that communicate the identification of the bezel to the processor, which loads corresponding software programs stored in memory that are applicable to the bezel's configuration.

Claim 15 includes the limitation of "identification means for indicating the assigned operational function given to each of the input mechanisms." In rejecting this claim under §102, the Patent Office must show that this feature is expressly taught by the cited reference. However, the Office Action points to the following passage in its analysis of this element:

"allow the microprocessor in an audio component to automatically identify the software routines needed for providing features in

correspondence with the buttons on a particular bezel based upon the particular bezel assembled to the audio component." [col. 2, ll. 5 - 10].

The cited passage fails to teach the claimed element. Where the Applicant's claim calls for "identification means" directed to the newly assigned operational function given to each input mechanism, the cited portion of the Hamel reference speaks to the identification of "software routines" which are used to configure the audio component. Nothing in the reference demonstrates the claimed identification means claimed, and the claim is not properly rejected under 35 U.S.C. §102 because it fails to teach all of the claimed elements, and thus there is no identity of invention.

Moreover, there would be no teaching or suggestion to modify the Hamel apparatus to include the "identification means" of Claim 15. That is, the object of the Hamel device is to conform an audio component automatically with a recognized bezel using pre-stored program routines, and thus there is no post-assignment "identification means" necessary because the particular bezel is "unique" to the assigned functions. Thus, any suggestion to employ such identification means would be unnecessary and contrary to the teachings of the cited reference.

Further, Claim 15 calls for a first set of input mechanisms and a second set of input mechanisms, where the first set has common characteristics that differ from the common characteristics of the second set of input mechanisms. In the Office Action of the parent application, it cites to a single passage to show *both* claimed sets of input

mechanisms. The cited passage fails to show two sets of input mechanisms having different characteristics and thus the rejection of claim 15 is under 35 U.S.C. §102 is improper for yet a second reason. Because Claim 15 is patentable over Hamel, Applicant submits that dependent claims 16 and 17 are similarly patentable for the reasons set forth above.

### **Claims 18 - 21**

In the parent application, Claims 10 - 13 (now claims 18 - 21) were rejected under 35 U.S.C. §103 as being obvious over Hamel in view of Hohner, U.S. Patent No. 5,437,044. In order to reject a claim for obviousness, three criteria must be met. To establish a *prima facie* case of obviousness, the Office Action must achieve three objectives: (1) The Office Action must demonstrate suggestion or motivation, either in the references themselves or in the prior art, to modify the reference as suggested by the Office Action or to combine the references as suggested by the Office Action; (2) The Office Action must establish that the proposed combination has a reasonable expectation of success; and (3) The Office Action must demonstrate that each claim limitation in each claim is taught or suggested in the cited references. M.P.E.P. §706.02(j).

In rejecting current Claim 18 (previous Claim 10), the Office Action stated that Hamel teaches a radio control device comprising a plurality of interchangeable input mechanisms, each input mechanism assignable by a user .... However, Hamel's teaching lacks this feature. In the present invention, each button is available to be assigned by the

user to accommodate the particular preference of the user, so that volume for example can be placed in the most readily accessible location or squelch can be assigned to a button of lesser accessibility. In Hamel, however, input devices are assigned based on the bezel configuration, not the user's preference, and the available configurations are limited by the available bezels. Therefore, unlike the present invention the input mechanisms are not *assigned by a user* and the cited reference fails to teach the claimed limitation.

The Office Action acknowledges that Hamel fails to teach a data port for receiving instructions from an external computer where "said assignments of each radio control operational function by the user are first performed on an external computer, and then such assignments are converted into instructions for the controller and communicated by the external computer to the controller of the radio control device via the data port." To overcome the deficiencies of Hamel, the Office Action attempts to incorporate the teachings of Hohner. Hohner teaches a unit for facilitating debugging of programming by simulating the operational unit on a computer. There, the programming can be tested before loading on to the operational unit rather than testing the software on the actual unit and then debugging. The Office Action states without support that it would have been obvious to incorporate the Hohner teachings into the Hamel device "because it would provide for reprogramming the microprocessor within the radio control device for different radio configurations."

There are three shortcomings to the Office Action's assertion. First, the object of the Hamel device as discussed at length in the background and summary of the invention is to **avoid** the type of itemized programming. The benefit of the bezel recognition is that the audio device programs itself, and the entire benefit would be lost by altering the configuration as proposed by the Office Action. Second, there is no teaching in Hohner as the Office Action suggests for "coordinating the input mechanisms with their respective assigned control operational function, where said assignments of each control operational function by the user are first performed on an external computer ...." That is, while the programming of the Hohner device is carried out on a personal computer there is no teaching of assigning input mechanisms on the operational device. Rather, the programming is carried out using the same configuration of the keypad of the operational device, and thus no "assignment" is performed. Third, the bald conclusory assertion that the proposed combination would have been obvious is unsupported by any teaching or suggestion to be found in the references or the art. Instead, the Office Action has identified references in an attempt to show the individual elements of the claimed invention were known without showing that one of ordinary skill in the art, without knowledge of the Applicant's disclosure, would have been compelled to make the combination proposed by the Office Action.

As has been stated many times, virtually every invention is a composition of known elements. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 149 F.3d 1350 (Fed. Cir. 1998). In *Rouffet*, the court concluded that:

[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’ *Id. at 1357.*

The court pointed to the absence of any teaching *in the cited references* for making the proposed modifications, and found that the board had reversibly erred in determining that the invention was rendered obvious because there was no identification of motivation to choose the selected references for combination.

Accordingly, “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361 (Fed. Cir. 2000). “The absence of such a suggestion to combine is *dispositive* in an obviousness determination.” *Gambro Lundia AB v. Vaxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

Claim 18 is asserted to be patentable over the cited art, because the proposed combination would be contrary to the teachings of Hamel which *teaches away* from the approach proposed by the Office Action and because the proposed combination lacks a teaching or suggestion in the prior art. Claim 19 is also patentable over the cited art, in that the Office Action apparently confused the “interchangeable input mechanisms” (i.e., the push buttons, dials, and the like) with Hamel’s finger pad 30 which is a sensor for

reading the tabs on the bezel. Thus, there is no teaching that Hamel teaches or suggests "interchangeable input mechanisms ... located in pairs, and each input mechanism of said pairs are located on respective right and left hand sides of the radio controlled device."

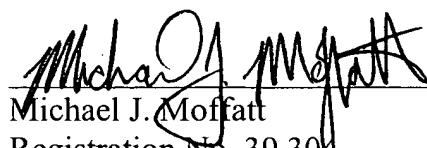
Similarly, the previous rejection of Claim 21 (formerly Claim 13) suffers from the apparent confusion between the input mechanisms and Hamel's bezel tabs used to identify the bezel type to the processor. It is respectfully submitted that the claims are thus patentably distinguishable over the Hamel and Hohner teachings.

New Claim 22 is respectfully submitted for consideration. After reviewing the cited art, Applicant asserts that Claim 22 is patentable and requests that each of the pending claims be passed to allowance. If the examiner believes that a telephone interview will further the prosecution of this case, the examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

By:

  
Michael J. Moffatt  
Registration No. 39,304

200 Oceangate, Suite 1550  
Long Beach, CA 90802  
Telephone: (562) 432-0453  
Facsimile: (562) 435-6014  
Customer No. 27629